



20 MAR 2007

23908
RENNER OTTO BOISELLE & SKYLAR, LLP
1621 Euclid Ave.
Nineteenth Floor
Cleveland, OH 44115

In re Application of
CHERNYSH *et al*
U.S. Application No.: 10/585,715
PCT No.: PCT/RU04/00541
Int. Filing Date: 30 December 2004
Priority Date: 15 January 2004
Attorney Docket No.: SPSUP0100WOUS
For: ANTITUMORAL AND ANTIVIRAL
PEPTIDES

DECISION

This decision is in response to applicants' petition Under 37 CFR 1.47(a) filed 25 January 2007.

BACKGROUND

On 18 January 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 25 January 2007, applicants filed a response which was accompanied by, *inter alia*, a declaration signed by one of the two named inventors and a statement by Sergey I. Chernysh.

DISCUSSION

Applicants claim that joint inventor German P. Bekker refuses to cooperate in the above-identified application and have filed a petition under 37 CFR 1.47 in response to the Form PCT/DO/EO/905 mailed 18 January 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Concerning item (1), the petition fee of \$200.00 has been paid.

With regards to item (3), the last known address of co-inventor German P. Bekker is listed as:

Ozernaya 30
Building 2, App. 44
119361 Moscow, Russia

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by one of the two co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, address and citizenship of all three inventors are recorded on the declaration. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Hence, items (1), (3) and (4) of 37 CFR 1.47(a) are complete.

Regarding item (2), applicants' submitted a declaration by co-inventor Sergey I. Chernysh who states that he presented "the application papers for execution to Mr. Bekker on 05.24.2006 at St. Petersburg Russia. Mr. Bekker refused to sign the documents." No other evidence was provided.

Section 409.03(d) of the MPEP discusses a refusal to join and states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. . . .

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts.

It is not clear whether Mr. Chernysh presented a complete copy of the application papers including specification, claims, drawings and the declaration to the nonsigning inventor. Petitioners did not provide a copy of what was presented to Mr. Bekker and the statement by Mr. Chernysh is not specific enough. A declaration by Mr.

Chernysh explaining what was presented to the nonsigning inventor along with a copy of those documents is required for the refusal to be accepted under these facts.

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302